

REMARKS

Rejection under 35 U.S.C §112

Claims 16, 17 stand rejected under 35 U.S.C. 112 as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. In particular, the Examiner finds that apparatus claims 16, 17 depend on process claim 1. Claim 16 has been made dependent on apparatus claim 9. Claim 17 has been made dependent on claim 16. Accordingly, the Applicant respectfully requests the Examiner to withdraw this rejection.

Rejection under 35 U.S.C §103

Claims 1-3, 5, 7-13 stand rejected under 35 U.S.C. 103(a) as being unpatentable over WO 99/16003 to Newman in view of U.S. Pat. No. 5,860,071 to Ball et al. Claim 4 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Newman in view of Ball and further in view of U.S. Pat. No. 5,710,884 to Dedrick. Claim 6 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Newman in view of Ball and further in view of U.S. Pat. No. 6,035,339 to Agrapharam. Claims 14-17 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Newman in view of Ball and further in view of U.S. Pat. No. 6,330,569 to Baisley. The Applicant respectfully disagrees.

Rejection of claim 1

In the action, the Examiner asserts that Newman teaches a process for personalized access to information available on the Internet network comprising "generating a HTML page in the user's computer" (page 5, line 1 – page 6, line 3). However, the Applicant notes that Newman discloses (page 5, line 31 – page 6, line 5) a process wherein "*when the client computer 11(c) receives the Web page, including the respective conditional items, it will use "personal information" which it (that is, the client computer 11 (c)) maintains concerning itself or the particular operator to select one of the conditional items. If the selected conditional item comprises a content item or alternative text that is provided in the conditional item itself, the client computer 11 (c) can display the selected conditional item in the respective frame or other portion of the Web page.*" The process of

Newman provides for receiving a web page (or HTML page), and eventually amending portions of the web page it (by displaying selected conditional item), i.e. a process ending with an HTML page comprising a certain amount of non-amendable data chosen by the HTML page provider (i.e. the "*supplemental content*" such as "*advertising information to be displayed with the web page*" of page 7, lines 5-10). The Applicant submits that a process wherein the provider keeps control over at least part of the data in the end HTML page, such as Newman's, teaches away from a process generating an HTML page in the user's computer, and having full control over the data entered in the end HTML page. The Applicant therefore respectfully submits that the process of Newman cannot be deemed to disclose or suggest a process comprising "generating an HTML page in the user's computer describing said selected services" as recited in claim 1.

The Applicant submits that the Examiner fails to show that Ball discloses or suggest a method as recited in claim 1, and in particular comprising "generating an HTML page in the user's computer describing said selected services", and therefore fails to show that a combination of Newman and ball would disclose or suggest a method as recited in claim 1, and in particular comprising "generating an HTML page in the user's computer describing said selected services". The Applicant therefore respectfully submits that claim 1 is patentable over Newman in view of Ball. Should the Examiner disagree, Applicants respectfully request him to clearly and specifically point out where Newman or Ball disclose the above feature in accordance with 37 C.F.R. 1.104(c)(2).

Rejection of claim 8

The Applicant respectfully submits that the above arguments with regard to claim 1 can be used to show that Newman and Ball do not suggest, alone or in combination, a computer program product as recited in claim 8 and comprising computer program code for, when executed on a computer, performing all the steps of claim 1, in particular "generating an HTML page in the user's computer describing said selected services". The Applicant therefore submits that claim 8 is patentable over Newman in view of Ball.

Rejection of claim 9

The Applicant respectfully submits that the above arguments with regard to claim 1 can be used to show that Newman and Ball do not suggest, alone or in combination, an apparatus as recited in claim 9, and in particular comprising "*means for generating a HTML page in the user's computer comprising said selected pieces of information*". The Applicant therefore submits that claim 8 is patentable over Newman in view of Ball.

Rejection of claim 2-3, 5, 7 and 10-13

Claims 2-3, 5, 7 and 12 depend directly or indirectly on claim 1; claims 10, 11 and 13 depend directly or indirectly on claim 9. The Applicant submits that at least in view of their dependency, claims 2-3, 5, 7 and 10-13 are patentable over Newman in view of Ball.

Rejection of claim 4

The Applicant submits that the Examiner fails to show that Dedrick discloses or suggest a method as recited in claim 1, and in particular comprising "*generating an HTML page in the user's computer describing said selected services*", and therefore fails to show that a combination of Newman, ball and Dedrick would disclose or suggest a method as recited in claim 1, and in particular comprising "*generating an HTML page in the user's computer describing said selected services*". Claim 4 depends on claim 1; the Applicant submits that at least in view of its dependency, claim 4 is patentable over Newman in view of Ball and further in view of Dedrick.

Rejection of claim 6

The Applicant submits that the Examiner fails to show that Agraharam discloses or suggest a method as recited in claim 1, and in particular comprising "*generating an HTML page in the user's computer describing said selected services*", and therefore fails to show that a combination of Newman, ball and Agraharam would disclose or suggest a method as recited in claim 1, and in particular comprising "*generating an HTML page in the user's computer describing said selected services*". Claim 6 depends on claim 1; the Applicant submits that at least in view of its dependency, claim 6 is patentable over Newman in view of Ball and further in view of Agraharam.

Rejection of claims 14-17

The Applicant submits that the Examiner fails to show that Baisley discloses or suggest a method as recited in claim 1, and in particular comprising "*generating an HTML page in the user's computer describing said selected services*", and therefore fails to show that a combination of Newman, ball and Baisley would disclose or suggest a method as recited in claim 1, and in particular comprising "*generating an HTML page in the user's computer describing said selected services*", or an apparatus as recited in claim 9 and in particular comprising "*means for generating a HTML page in the user's computer comprising said selected pieces of information*". Claims 14-15 depend directly or indirectly on claim 1 and amended claims 16-17 depend directly or indirectly on claim 9; the Applicant submits that at least in view of their dependency, claims 14-17 are patentable over Newman in view of Ball and further in view of Baisley.

In view of the above, the Applicant submits that the application is now in condition for allowance and respectfully urge the Examiner to pass this case to issue.

The Commissioner is authorized to charge any additional fees that may be required or credit overpayment to deposit account no. 08-2025. In particular, if this response is not timely filed, the Commissioner is authorized to treat this response as including a petition to extend the time period pursuant to 37 CFR 1.136(a) requesting an extension of time of the number of months necessary to make this response timely filed and the petition fee due in connection therewith may be charged to deposit account no. 08-2025.

I hereby certify that this correspondence is being deposited with the United States Post Service with sufficient postage as first class mail in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on

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